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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,213	10/28/2003	Kazunori Horikiri	117616	3001
25944 7590 03/22/2007 OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER HOANG, HIEU T	
			ART UNIT 2152	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS			MAIL DATE 03/22/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/694,213

Applicant(s)

HORIKIRI ET AL.

Examiner

Hieu T. Hoang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/28/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This office action is in response to communication filed on 10/28/2003.
2. Claims 1-25 are pending and presented for examination.

### ***Drawings***

3. Figure 56 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

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by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-25 of the current application (hereafter '213) are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 11/045270 (hereafter '270). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention is a conference system with a management server and a plurality of site systems or on-site servers (claim 1 of '213 and claims 1 and 8 of '270), wherein the management server manages session information (user ID, workspace ID,

or session ID) in a shared workspace (claims 2, 3 of '213 and claims 2-4 of '270), the claim invention also involving user authentication (claims 2, 5 of '213 and claims 2, 3 of '270), a card reader for reading IC card information (claims 7, 9, 22, 24 of '213 and claim 5 of '270), a database for storing user information or reference (claim 5 of '213 and claims 12-16 of '270).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 14 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "opening a workspace in response to workspace selection of a user" contradicts with the previous limitation "providing a workspace." Since there is only one workspace, "workspace selection" is vague and indefinite. Appropriate correction is required. For examining purpose, the examiner will interpret the phrase "workspace selection" as workspace activation by the user (with the use of a mouse). Furthermore, the claims show no explicit difference between a workspace provided, a workspace opened, a workspace being active, and a workspace being managed, and as to where these workspaces are located. As best understood by

the examiner, a workspace is a conference session. When a user joins an existing conference, his or her workspace or session will be added to the existing conference.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 25 is rejected under 35 U.S.C. 101 as the claimed invention is directed to non-statutory subject matter. A computer program described in a computer-readable format is software, per se, and is non-statutory subject matter. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-6, 8, 10-14, and 16-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Dalal et al. (US 2003/0014488, hereafter Dalal).

12. For claim 1, Dalal discloses a teleconference system for supporting realization of cooperative work among a plurality of conference systems (abstract), the teleconference system comprising:

- site systems each being installed at a plurality of sites respectively, and each configured to operate the corresponding conference system (fig. 1, clients with client conference controllers); and
- a shared workspace server configured to connect the site systems to each other (fig. 1, conference service provider) and to share a workspace of an object for managing and using a task as a cooperation unit among the sites (fig. 2, [0012]).

13. For claim 2, Dalal further discloses the shared workspace server is further configured to manage a session for managing connection of the site systems ([0019]-[0021]), a file used in a conference and created as a record of the conference ([0036], lines 11-20), reference information to a resource relevant to the conference ([0049], claim 6), and history information of file access made by conference participants ([0036] lines 5-12).

14. For claim 3, Dalal further discloses the shared workspace server is further configured to provide a user interface for connecting a session and making reference to a file and/or a resource (fig. 5, web browser, [0097]).

15. For claim 4, Dalal further discloses the shared workspace server is further configured to instruct, when a client starts a session, all other clients already starting the session to connect to the client ([0043], [0058]).

16. For claim 5, Dalal further discloses the site system comprises: an electronic whiteboard configured to provide a graphical user interface provided by a shared workspace (fig. 5, web browser providing a shared workspace, [0097]); a video and audio server configured to code and decode video and audio and to transmit and receive video and audio to and from any other site system for sharing motion and behavior of participants at the sites ([0024], [0031], [0080]); an authentication unit configured to authenticate identification of the participants ([0047], [0036]); and a site server configured to manage a session in the site systems (fig. 1, client session controller), a file used in a conference and created as a record of the conference, reference information to a resource relevant to the conference, and history information of file access made by the participants ([0036] lines 5-20).

17. For claim 6, Dalal further discloses the shared workspace server is further configured to select a workspace based on user identification information transmitted from the site system ([0030]).



18. For claim 8, Dalal further discloses the shared workspace server is further configured to select a workspace based on workspace specification information transmitted from the site system ([0036] lines 5-9).

19. For claim 10, Dalal further discloses the shared workspace server is further configured to respond to a file reference request received from the site system, to start application software to reference the file, and to provide an input/output interface with the application for each site system with a session established ([0036], [0096]).

20. For claim 11, Dalal further discloses the shared workspace server is further configured to, in a case where the file specified in the file reference request is not previously registered in the workspace, temporarily register the file ([0057] lines 1-6, [0058] lines 1-6).

21. For claim 12, Dalal further discloses the site system is configured to start application software to reference the file specified in a file reference request, and to provide an input/output interface with the application for any other site system with a session established ([0036], [0096]).

22. For claim 13, Dalal further discloses the site system is further configured to receive the file specified in a file reference request from any other site system, to start application software to reference the file, and to provide an input/output interface with

the application for any other site system with a session established ([0046] lines 10-18, [0036], [0096]).

23. For claim 14, Dalal discloses a teleconference support method for supporting realization of cooperative work among a plurality of conference systems, the method comprising:

- providing a workspace comprising one or more sessions ([0025], [0021]);
- opening the workspace in response to workspace selection of a user ([0051], joining a conference, [0055]);
- adding the opened workspace to an active workspace ([0054]-[0055], [0061] lines 14-18); and
- managing use of the workspace ([0026] lines 1-11).

24. For claim 16, Dalal further discloses the managing use of the workspace includes providing a user interface for making reference to a file and/or a resource (fig. 5, web browser, [0097]).

25. For claim 17, Dalal further discloses the managing use of the workspace includes registering reference to a file and/or a resource ([0036] lines 5-20).

26. For claim 18, Dalal further discloses the managing use of the workspace includes switching a workspace, starting a subworkspace, and terminating the workspace

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([0067]-[0069], switching a workspace is just terminating the workspace and start a new workspace or subworkspace).

27. For claim 19, Dalal further discloses in the managing use of the workspace, the original workspace is deactivated in the switching of the workspace and/or in the starting of the subworkspace ([0069], the real-time session is closed with the SPMS before a user can start a new workspace (or switch to a new workspace)).

28. For claim 20, the claim is rejected for the same rationale as claim 4.

29. For claim 21, the claim is rejected for the same rationale as claim 6.

30. For claim 22, the claim is rejected for the same rationale as claim 7.

31. For claim 23, the claim is rejected for the same rationale as claim 8.

32. For claim 24, the claim is rejected for the same rationale as claim 9.

33. For claim 25, Dalal discloses a computer program described in a computer-readable format so as to execute processing for supporting realization of cooperative work among a plurality of conference systems in a computer system (abstract), the computer program comprising:

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- means for providing a workspace comprising one or more sessions ([0025] lines 17-25);
- means for opening the workspace in response to workspace selection of a user ([0051], joining a conference, [0055]);
- means for adding the opened workspace to an active workspace ([0054]-[0055], [0061] lines 14-18); and
- means for managing use of the workspace ([0026] lines 1-11).

***Claim Rejections - 35 USC § 103***

34. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dalal, as applied to claim 14 above.

36. For claim 15, Dalal substantially discloses the invention as in claim 14 above.

Dalal does not explicitly selecting a workspace from a plurality of workspace candidates from a user interface.

However, Dalal discloses the display of an invitation message so that the user can choose to join the conference, i.e. workspace, conference rooms ([0051],

conference information is displayed for the user to select, reading a workspace candidate as an invitation message displayed on the user interface).

Therefore, according to MPEP 2144.02, section VI(b), Duplication of Parts, it would have been obvious for one skilled in the art at the time of the invention to modify the teachings of Dalal in order to provide a plurality of invitation messages and then display a plurality of invitation messages to the user so that the user can select a conference or a workspace associated with an invitation message that he/she wants to join to provide more functionality to the system and more flexibility to the user (e.g., he/she can decide which conference is more necessary to attend now and which can be hold off).

37. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalal, as applied to claims 6 and 8 above, in view of Kisliakov (2005/0178833).

38. For claims 7 and 9, Dalal substantially discloses the invention as in claims 6 and 8 above. Dalal discloses the shared workspace server is configured to select the workspace based on the user identification information or workspace identification information transmitted by the site system. Dalal does not explicitly disclose that the identification information is transmitted using an IC card.

However, Kisliakov discloses using an IC card to store session and user identification information (see, e.g., [0227]).

Therefore, it would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Dalal and Kisliakov in order to store ID

information in a smart card therefore provide ease of ID information storage and retrieval with increased security protection (Kisliakov, [0002]).

### ***Conclusion***

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu T. Hoang whose telephone number is 571-270-1253. The examiner can normally be reached on Monday-Thursday, 8 a.m.-5 p.m., EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HH

  
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SUPERVISORY PATENT EXAMINER